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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/243,008	02/02/99	SEED	B 00786/270002

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HM12/1023

EXAMINER

NOLAN, P

ART UNIT

PAPER NUMBER

1644

DATE MAILED:

10/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/243,008

Applicant(s)
Seed et al.

Examiner
Patrick J. Nolan

Art Unit
1644



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 30, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-47, 51, 52, 56, 57, 60-64, 70, 72-75, 77, 79-82, and 92-101 is/are pending in the application.
- 4a) Of the above, claim(s) 56, 57, 60-64, 70, 77, 80-82, and 92-99 is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-47, 51, 52, 72-75, 79, 100, and 101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 11 20) ☐ Other: _____

Part III DETAILED ACTION

1. This application is a continuation of 08/394,176 which is continuation-in-part of 08/203,866 which is a continuation of 07/847,566 which is continuation-in-part of 07/665,961.
2. The request filed on 7-30-01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/243,008 is acceptable and a CPA has been established. An action on the CPA follows.
3. Claims 44-47, 51-52, 56-57, 60-64, 70, 72-75, 77, 79-82 and 92-101 are pending.
4. Claims 56-57, 60-64, 70, 77, 80-82 and 92-99 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions, for reasons supplied in Paper No.8 .
5. Claims 44-47, 51-52, 72-75, 79 and 101 may not have the benefit under **35 USC § 120** of the parent filing dates (2/28/94, 3/06/92, and 3/07/91), because the claimed chimeric receptors, specifically an intracellular CD28 portion, are not disclosed in the parent applications, serial numbers 08/203,866, 07/847,566 and 07/665,961.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 44-47, 51-52, 72-75, 79, 100 and newly added claim 101 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has no support in the originally filed claims or specification for the genus phrase language "an intracellular domain that does not signal to said cell to destroy a receptor-bound target cell or receptor-bound target infective agent", present in amended base claims 44 and 79.

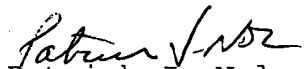
Applicant's arguments filed 7-30-01 have been fully considered but are not found persuasive.

Applicant argues they have support for the claimed invention

on page 48, lines 31-33, where they describe a chimera which has a full length extracellular domain, a full length transmembrane domain and a 3 amino acid intracellular domain. The specification further discloses this chimera was able to signal target cell destruction and they further characterize another chimera which had no intracellular domain and this chimera also was able to signal target cell destruction. From this disclosure Applicant's representative has concluded completely without any direct evidence that the first chimera that had only three amino acids intracellularly, was only working as a "nub" to anchor the chimera into the membrane and did not by her assertion act as a signal transmitter. It is because of these conclusory statements that Applicant's representative argues the specification has broad written support for a genus claim drawn to an "intracellular domain that does not signal to said cell to destroy a receptor-bound target cell or receptor-bound target infective agent". These amendments to the claims represent the creation of a sub-genus from the disclosure of a genus of receptor chimera and the possible disclosure of one chimera which includes a intracellular domain that may or may not signal said cell to destroy a receptor-bound target cell. This is not permitted as is recognized by the case law, "It cannot be said that a subgenus is necessarily described by a genus encompassing it and a species upon which it reads." In re Smith 173 USPQ 679, 683 (CCPA 1972). See MPEP 2163.05(b).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is (703) 305-1987. The examiner can normally be reached on Monday through Friday from 8:30 am to 4:30 pm.

8. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. The FAX number for our group, 1644, is (703) 305-7939. Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 308-0196.


Patrick J. Nolan, Ph.D.
Primary Examiner, Group 1640
October 19, 2001